

REMARKS

I. Status Of The Claims And The Rejections

Applicants note the acknowledgement in the Office Action of the acceptance of the priority claim under Section 119, and that all copies of the certified copies of the priority documents have been received by the USPTO.

Applicants also acknowledge the indication of allowable subject matter as to claim 19. Nonetheless, applicants choose not to rewrite claim 19 in independent form at this time, for the reasons explained below.

Claims 18-35 are pending in the application. In response to a Restriction Requirement, applicants expressly acknowledged the indication in the prior Office Action that claims 18-21, 25-32, and 34 are generic. In that same response, applicants elected Species A in Group II of the claims. More specifically, applicants asserted that dependent claims 32 and 35 correspond to Species A and depend from generic independent claims 18 and 34, respectively. Still further, in that same response applicants asserted that claims 23 and 24 are equally usable within the context of species A. Applicants expressly withdrew claims 22, 31, 33, and also withdrew claim 23 "to the extent necessary."

For these reasons, applicants respectfully assert that the Office Action Summary, i.e., page 2 of the recent Office Action, is incorrect. This Summary describes a "disposition of claims" that is inconsistent with the current status of pending claims 18-35. More particularly, the Summary indicates that claims 20, 22, 23, 32, and 33 are withdrawn from consideration. And at page 3 of the Office Action, in paragraph 2, the Office Action restates this same group of claims as identified on page 2. For the reasons asserted above, applicants respectfully assert that these recitations are incorrect.

This recitation of withdrawn claims should not include claim 20. Given that the Office Action includes a substantive rejection of generic claim 20, perhaps the inclusion of claim 20 in this list of claims is merely a typographical error.

Also, claim 32 appears to be incorrectly grouped with the withdrawn claims. Claim 32 should have been subject to substantive examination, based on the response to the Restriction Requirement. It is claim 31 that should have been withdrawn. In other words, it appears that claims 31 and 32 have been inadvertently transposed in position.¹

The Office Action identifies a rejection to the drawing, particularly with respect to reference numeral 62. Applicants have amended the specification at page 8, by deleting previously identified reference numeral 58 and adding reference numeral 62. Also, applicants have amended the drawings to conform to the specification, to show that reference numeral 58 refers to cooling structure and reference numeral 62 refers to cables.

Applicants note that reference numbers 24 and 26, in original Fig 3, were inadvertently transposed. In the accompanying corrected Fig 3, reference numeral 24 refers to the inner wall 24 and reference numeral 26 refers to the outer wall. As corrected, Fig 3 is now consistent with the written specification.

The Office Action identifies a number of claim objections based on the use of the term "and/or." The claims have been amended to eliminate this informality. Also, claims 21 and 30 are specifically objected to because of inconsistencies with respect to dependencies. This response corrects these two claims with respect to these informalities, and also eliminates the use of "and/or."

¹ For these reasons, in the claims presented above, applicants have marked claim 31 as "withdrawn" and claim 32 as "previously presented," to correctly characterize the actual status of these claims. If the examiner disagrees, the undersigned attorney respectfully requests that he be contacted by telephone.

Substantively, claim 34 was rejected for alleged lack of novelty under Section 102(b), based on Morisawa et al., U.S. Patent No. 5,590,631 ("Morisawa '631"). Claim 35 was rejected for alleged obviousness under Section 103, based on Morisawa '631 in combination with Fliege U.S. Patent No. 5,678,646 ("Fliege '646"). Claims 18, 20, and 24-31 were rejected for alleged obviousness under Section 103, based on this same combination of Morisawa '631 and Fliege '646.

Applicants respectfully traverse the rejections. Nonetheless, claims 34 and 35 are withdrawn, so the first two of the three above-identified substantive rejections are now moot. Applicants respectfully request reconsideration of the claims.

II. The Claimed Subject Matter

With claims 34 and 35 withdrawn, the only remaining substantive rejection relates to claims 18, 20, 21, 24-30, and 32. That is, as noted above, claim 21 was deserving of examination on the merits, (and in fact was objected to in the Office Action,) because applicants did not previously withdraw it. Moreover, as noted above, claim 31 was previously withdrawn, whereas claim 32 was not. Thus, this response asserts the patentability of claims 20, 21, and 32.

Each of claims 20, 21, 24-30, and 32 depends upon claim 18. Independent claim 18 is directed to a hybrid drive for a motor vehicle with a drive train (1). The hybrid drive includes a combustion engine (20) and vehicle transmission (3) with variable gear ratio, along with first and second electrical machines (4, 6). Each of the electrical machines can be operated both as a motor and a generator, and each comprises a stator (34, 44) and a rotor (38, 48). The second electrical machine (6) is in a permanent non-positive connection with an input (5) of the vehicle transmission. First and second shiftable clutches (7, 8) are arranged between the first and second machines (4, 6) and the drive shaft and the combustion engine (2). The electrical machines (4, 6) are connected with each other and also connectable with an electrical energy source (12) via a

power actuation control (11). The two electrical machines (4, 6) are arranged in a common housing (20).

More specifically, the two stators (34, 44) of the two electrical machines (4, 6), and the power actuation control (11) are accommodated on a common carrier (22) which comprises a cooler (52) for cooling the stators (34, 44) or the power actuation control (11). In claim 18, this last feature is recited as "for cooling at least one of: a) the stators (34, 44) and b) the power actuation control (11)," so as to avoid the use of alternative language.

The various dependent claims recite one or more additional features in combination with the features set forth in independent claim 18. The Office Action has already indicated that claim 19, and hence the combined subject matter of dependent claim 19 and independent claim 18, is allowable. Applicants respectfully assert that claim 18, and likewise each of dependent claims 20, 21, 24-30, and 32 is also allowable.

III. The Deficiencies Of The Cited Prior Art

Applicants respectfully disagree with the Office Action's characterization of Morisawa '631. For instance, Morisawa '631 fails to show a shiftable clutch arranged between electrical machines and the drive shaft of the combustion engine. Morisawa '631 also fails to disclose a carrier of the type recited in claim 18.

The Office Action asserts that common housing 101 of Morisawa '631 "acts as a common carrier for both stators, as shown in Figs 1-3." However, claim 18 recites that the two stators (34, 44) of the electric machines (4, 6) are accommodated on a common carrier, and the two stators (34, 44) of the two electrical machines (4, 6) are in a common housing (20). (emphasis added) Thus, claim 18 recites a carrier (22) within a housing (20). Perhaps the housing (20) of claim 18 could arguably correspond to the housing (101) of Morisawa '631. But

certainly the housing (101) of Morisawa '631 can not also be a carrier inside the housing, as recited in claim 18.

Simply stated, Morisawa '631 does not disclose a common carrier (22) for the two stators and the power actuation control (11). And finally, Morisawa '631 fails to disclose a common carrier (22) which comprises a cooler (52) for cooling the stators (34, 44) or the power actuation control (11). Instead, Morisawa '631 discloses a flywheel (106) (see Figs 1 and 3), and a damper (107) between the electrical machines and the drive shaft.

Fliege '646 fails to show a shiftable clutch arranged between the electrical machines and the drive shaft of the combustion engine. Moreover, Fliege '646 fails to disclose a carrier for the two stators. Applicants respectfully disagree with the assertion in the Office Action, that Fliege '646 discloses a "carrier." Rather, reference numerals 7-9 in Fliege '646 refer to "two second modular units 7 and 9, connected to the first modular unit 3. (See col 7, lines 56-57.) These modular units 7, 9 of Fliege '646 do not correspond to a carrier (22) that is located within a housing (20), as recited in claim 18.

Moreover, Fliege '646 does not disclose a common carrier that carries the power actuation control and the stators. Rather, in Fliege '646 the power actuation control is mounted on a mounting board 99 that is arranged opposite the electrical machine

IV. The Claims Are Patentable

A person of ordinary skill in the art would not have combined the cited references in the manner suggested. First of all, neither of the two relied-upon references supplies any teaching, suggestion, or motivation for making the alleged combination. The Supreme Court stated in *KSR* that the teaching, suggestion, motivation test is still a valid test for determining obviousness. It remains relevant to this analysis. And under this still-relevant test, this rejection is improper.

Moreover, the Office Action fails to supply any objective reason for making the relied-upon combination of these two prior art references. Instead, the rejection reads as if someone is merely compiling a list of parts, randomly selected from these two prior art references. This is a clear example of improper hindsight.

Still further, even if a person of ordinary skill in the art were to combine the two cited references, the resultant hypothetical combination would be deficient. More particularly, the resultant hypothetical combination would still lack a common carrier for the two stators and the power actuation control, because neither of these two cited references discloses a common carrier of the type shown and described, which is located inside a common housing.

For these reasons, applicants respectfully assert that the obviousness rejection of claim 18 is improper, and should be withdrawn.

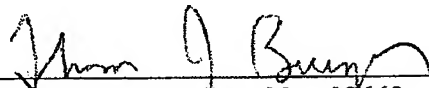
Additionally, each of dependent claims 20, 21, 24-30, and 32 recites one or more additional features in combination with the features of claim 18. Based on the same arguments set forth herein as to claim 18, and also because the Office Action is at least as deficient with respect to the combinations of features set forth in these dependent claims, applicants respectfully assert that each of these dependent claims is also patentable.

V. Conclusion

Based on these amendments and these Remarks, applicants respectfully submit that the claims are in condition for allowance, and request that they be allowed without further delay.

It is believed that no fee is due for this filing. If any fee is deemed due, consider this as an authorization to charge Deposit Account 23-3000 therefore.

Respectfully submitted,
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Fig. 3

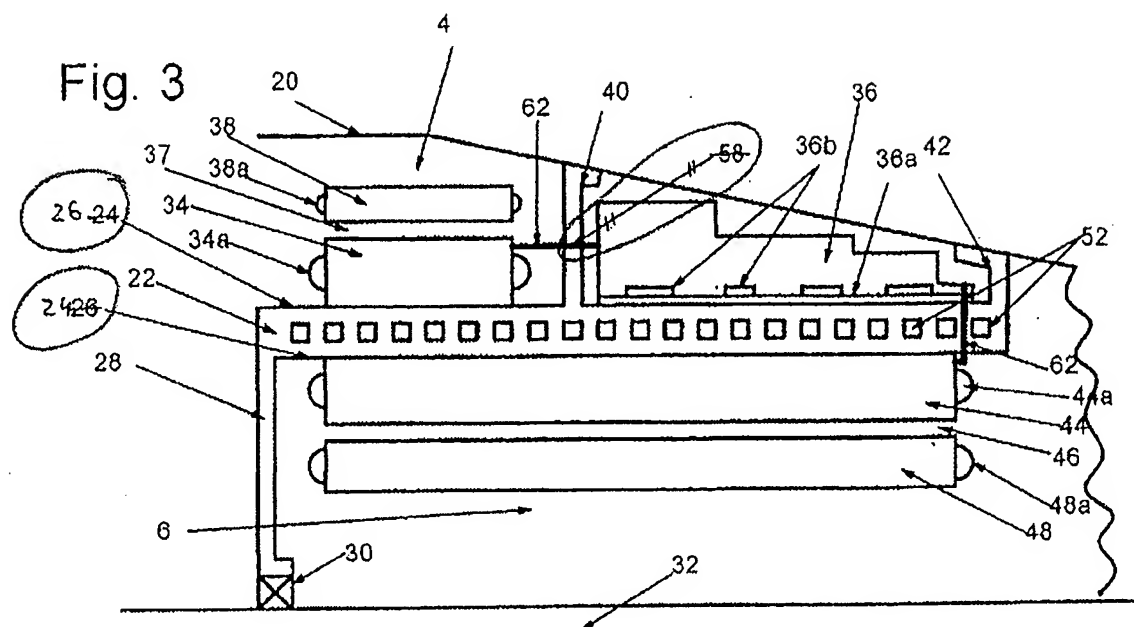


Fig. 4

